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REMARKS

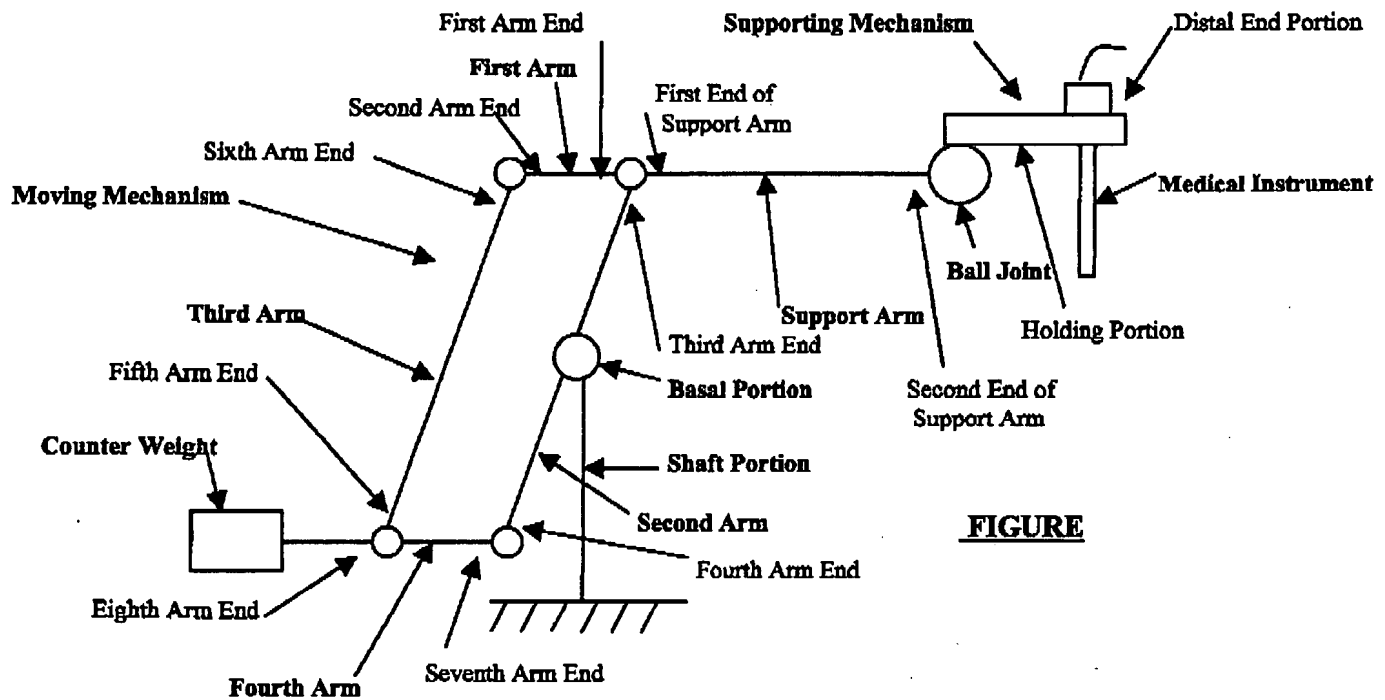
Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claims 7, 9, 13, 15, 20, 22 and 26 contain allowable subject matter and would be allowed if the rejection under 35 U.S.C. 112, second paragraph is overcome.

In the Official Action, the Examiner rejects claims 1-34 under 35 § U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In response, the claims have been amended to clarify the same and to address the Examiner's comments with respect to claims 3, 4, 7, 9, 10, 13, 15, 16, 17, 20, 22, 23, 26, 28, 29 and 31.

The following Figure is for the convenience of the Examiner in understanding the amended claim language. The Figure provides an exemplary schematic of a holding apparatus using the terms recited in the claims and is provided by way of example only and not to limit the scope of the claims.



**FIGURE**

Accordingly, it is respectfully requested that the rejection of claims 1-34 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claims 1, 7, 9, 13, 15, 20, 22, 26, 27 and 30 under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements. Specifically, the Examiner argues that the ball joint is cited as coupling the moving mechanism to the supporting mechanism, yet the supporting mechanism includes a support arm with the ball joint. Thus, the Examiner concludes that the ball joint couples the support arm to the medical instrument holder and is not directly coupled to the moving mechanism.

Applicants respectfully submit that the support arm is not a necessary feature of the broader independent claims and therefore, the ball joint connects the moving mechanism to the supporting means (either directly or through other structure, such as the support arm). In order to clarify such a structural relationship, claims 1, 7, 9, 13, 15, 20, 22, 26, 27 and 30 have been amended to clarify that the ball joint is located between the moving mechanism and the supporting mechanism to operatively connect the moving means and the supporting means. Furthermore, claim 3, which does recite the support bar, has been amended to clarify that the combined center of gravity is located on a longitudinal axis of the supporting mechanism between the ball joint and the distal end portion of the supporting mechanism.

Accordingly, it is respectfully requested that the rejection of claims 1, 7, 9, 13, 15, 20, 22, 26, 27 and 30 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claims 1-6, 10-12, 14, 16-19, 21, 23-25 and 27-32 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application

Publication No. 2001/0027313 to Shimmura et al., (hereinafter "Shimmura"). Furthermore, the Examiner rejects claims 33 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Shimmura.

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 102(b) and 103(a) for at least the reasons set forth below.

In the previous amendment, independent claims 1, 27 and 30 were amended to recite that the ball joint further supports the supporting mechanism from below the supporting mechanism in the direction of gravity to be pivotable with respect to the moving mechanism. In the "Response to Arguments" section of the Official Action, the Examiner argues that Shimmura discloses allowing the ball joint to be positioned in any part of the instrument holder, in reply to the applicant's remarks on independent claims 1, 27 and 30 dated October 26, 2006. The Examiner has provided no basis to support such an argument in the Official Action.

Applicants respectfully disagree with the Examiner's interpretation of that which is taught by Shimmura. Applicants respectfully submit that Shimmura does not teach such a configuration and Applicants can find absolutely no teaching or suggestion in Shimmura to support the Examiner's argument. The Applicants respectfully request that the Examiner provide a basis for such a statement by pointing out with particularity where such a feature is disclosed in Shimmura.

With regard to the rejection of claims 1-6, 10-12, 14, 16-19, 21, 23-25 and 27-32 under 35 U.S.C. § 102(b), a medical instrument holding apparatus having the features discussed above and as recited in independent claims 1, 27 and 30, is nowhere disclosed in Shimmura. Since it has been decided that "anticipation requires the presence in a single prior

art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"<sup>1</sup> independent claims 1, 27 and 30 are not anticipated by Shimmura. Accordingly, independent claims 1, 27 and 30 patentably distinguish over Shimmura and are allowable. Claims 2-6, 10-12, 14, 16-19, 21, 23-25, 28, 29, 31 and 32 being dependent upon claims 1, 27 and 30, are thus at least allowable therewith.

With regard to the rejection of claims 33 and 34 under 35 U.S.C. § 103(a), since independent claim 30 patentably distinguishes over the prior art and is allowable, claims 33 and 34 are at least allowable therewith because they depend from an allowable base claim.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli  
Registration No. 39,533

Scully, Scott, Murphy & Presser, P.C.  
400 Garden City Plaza, Ste. 300  
Garden City, New York 11530  
(516) 742-4343  
TS:cm

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<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).